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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,526	09/27/2001	Shinji Tomita	KPC-294	9267

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WASHINGTON, DC 20036

EXAMINER
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SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/963,526

Applicant(s)

TOMITA ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/11/05 & 11/29/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

#### **Claim Rejections - 35 USC § 103**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blum et al. (U.S. 6,706,801).

The rejection is adequately set forth in paragraph 4 of the office action mailed 5/12/05 and is incorporated here by reference.

#### **Response to Arguments**

3. Applicants' arguments filed 10/11/05 and 1.132 declaration filed 11/29/05 have been fully considered but they are not persuasive.

Blum et al. disclose coating method as presently claimed wherein the method uses coating composition wherein the ratio of isocyanate group in the polyisocyanate to 1 equivalent of hydroxy group in the acrylic resin is 0.5-2 while the present claims require ratio of greater than 2 (claims 3-4) or 2.2 (claims 5-8).

In the previous office action mailed 5/12/05, the examiner argued that the instantly claimed ratio and that taught by Blum et al. are so close to each other that the fact pattern is similar to the one in *In re Woodruff*, 919 F.2d 1575, USPQ2d 1934 (Fed. Cir. 1990) or *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed.Cir. 1985) where despite

a “slight” difference in the ranges the court held that such a difference did not “render the claims patentable” or, alternatively, that “a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough so that one skilled in the art would have expected them to have the same properties”.

In light of the case law cited above and given that there is only a “slight” difference between the ratio disclosed by Blum et al. and the ratio disclosed in the present claims, it was the examiner’s position that it would have been obvious to one of ordinary skill in the art that the ratio disclosed in the present claims is but an obvious variant of the ratio disclosed in Blum et al., and thus, one of ordinary skill in the art would have arrived at the claimed invention.

In response, applicants have filed 1.132 declaration that compares coating method comprising coating of the present invention, i.e. wherein ratio of isocyanate group in the polyisocyanate to 1 equivalent of hydroxy group in the acrylic resin is 2.2, with coating method comprising coating outside the scope of the present claims, i.e. ratio of isocyanate group in the polyisocyanate to 1 equivalent of hydroxy group in the acrylic resin is 2. It is shown that the presently claimed coating is superior in terms of coating performance, i.e. surface gloss and substrate shielding ability.

However, it is the examiner’s position that the declaration is not persuasive for the following reasons.

Firstly, with respect to claims 3-4, it is the examiner’s position that the data is not commensurate with the scope of these claims. That is, present claims 3-4 require that the ratio of isocyanate group in the polyisocyanate to 1 equivalent of hydroxy group in the acrylic resin is “greater than 2.0”. However, the declaration only discloses one inventive example wherein the

ratio is 2.2. There is no data at the lower end of the claimed range, i.e. 2.01, 2.05, 2.1, etc. This is significant given that the presently claimed ratio “greater than 2.0” includes any amount greater than 2.0, i.e. 2.01, 2.05, 2.1, etc. and given that Blum et al. disclose ratio of 2.

Further, with respect to all the claims, it is noted that the declaration shows that the presently claimed coating is superior in terms of coating performance, i.e. surface gloss and substrate shielding ability.

However, it is the examiner’s position that the data is not persuasive given that there does not appear to be a significant difference between the coating within the scope of the present claims (coating I) and coating outside the scope of the present claims (coating II). That is, coating I is rated as having “good” gloss wherein “no influence” of paper scratch is observed while coating II is rated as having “slightly” lowered gloss wherein “slight influence” of paper scratch is observed. Thus, the only differences between the coating I and coating II are “slight” in terms of surface gloss and substrate shielding ability. It is not clear what, if any, difference there is between “good gloss” and “slightly” lowered gloss and “no influence” of paper scratch and “slight influence” of paper scratch. The results provided are not successful in establishing unexpected or surprising results over Blum et al. given that from the declaration, it cannot clearly be determined what or how significant the differences are between the presently claimed coating and that of Blum et al.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho  
Primary Examiner  
Art Unit 1714

CS  
2/16/06